

## **ADMINISTRATIVE PANEL DECISION**

Scribd, Inc. v. Hieu Pham  
Case No. D2024-2650

### **1. The Parties**

The Complainant is Scribd, Inc., United States of America (“United States”), represented by IPLA, LLP, United States.

The Respondent is Hieu Pham, Viet Nam.

### **2. The Domain Name and Registrar**

The disputed domain name <dlscrib.one> is registered with Spaceship, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 27, 2024. On June 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 1, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Spaceship, Inc. (Registrar)) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 3, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on July 5, 2024.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 11, 2024. The Respondent sent several email communications to the Center on July 8, July 10, July 11 and August 6, 2024. On July 10, 2024, the Center sent an email regarding possible settlement. The Complainant requested a suspension for settlement talks on July 17, 2024, the proceeding was then suspended until August 22, 2024. Further to the Complainant’s request for

reinstitution on August 5, 2024, the proceedings were reinstated as of August 6, 2024. The updated Response due date was August 11, 2024. The Center commenced Panel Appointment on August 13, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on August 16, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant offers under its main website “www.scribd.com” a user powered digital document library on various topics, inter alia academic papers, legal documents, manuals and more. It owns numerous SCRIBD-trademark registrations around the world, inter alia:

- United States trademark registration for SCRIBD (word), Reg. No. 3,777,227, registered April 20, 2010;
- International trademark registration for SCRIBD (word), Reg. No. 1422028, registered July 11, 2018;
- International trademark registration for SCRIBD (word), Reg. No. 1491187, registered August 6, 2019;
- Japanese trademark registration for SCRIBD (word), Reg. No. 6536157, registered March 29, 2022 (Annex 4 to the Complaint).

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The Complainant has registered its main domain name <scribd.com> to address its primary website on September 24, 2006 (Annexes 5 and 6 to the Complaint).

The disputed domain name was registered on February 12, 2024 (Annex 1 to the Complaint). At the time of filing the Complaint the disputed domain name resolved to a website which contained the Complainant’s mark SCRIBD together with information about “Scribd Downloader” and the possibility to download electronic files (Annex 7 to the Complaint).

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the SCRIBD trademark is well-known and distinctive and notes that the disputed domain name contains the SCRIBD trademark almost in its entirety, simply adding the prefix “dl”, which is a common abbreviation for “download” and omitting the letter “d” at the end.

Because of the widespread recognition of the Complainant’s trademark, the Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant’s trademark when registering the disputed domain name, or that there would be any legitimate use for the disputed domain name.

Further, the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SCRIBD trademark in any manner.

The Complainant also notes that the disputed domain name resolved to a website where the Complainant’s SCRIBD mark was reproduced and caused Internet users to err as to the source of the website to which the disputed domain name has resolved and the works made available therein; this constitutes bad faith since the disputed domain name primarily was used for the purpose of disrupting the business of a competitor and

to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's product or service.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Although the Respondent did not file a formal Response, it sent several email communications to the Center, most recently on August 6, 2024 asking: "How to transfer the domain to them?".

Even though this email communication from August 6, 2024 could be understood in a way that the Respondent has given consent to transfer (remedy sought by the Complainant) the disputed domain name to the Complainant, this Panel still finds it appropriate to proceed to a substantive decision on the merits.

There is ambiguity as to the scope of the Respondent's consent/contention, especially taking into account that the Respondent also offered to remove the content from the website, to disable the download function from the website. Finally no settlement was achieved between the parties during the suspension period.

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark SCRIBD.

In the present case the disputed domain name is confusingly similar to the SCIRBD mark in which the Complainant has rights.

The SCRIBD mark is distinctive and the disputed domain name only adds the prefix "dl", which is a common abbreviation for "download", and omits the letter "d" at the end, which is an obvious misspelling.

It has long been established under UDRP decisions that the mere addition of terms or omission of a letter will not prevent a finding of confusing similarity under the first element of the Policy, when the relevant trademark is recognizable within the disputed domain name ([WIPO Overview 3.0](#), sections 1.8 and 1.9). This is the case at present.

Finally, it has also long been held that generic Top-Level Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Based on the available record, the Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the

respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, since it has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SCRIBD trademark in any manner. The Respondent did not reply and hence has not rebutted the Complainant's contentions.

Further, the Complainant focuses on the fact that its trademark is distinctive and has a widespread recognition in the field of digital document libraries; moreover, the trademark SCRIBD is registered in a variety of jurisdictions around the world and it provides suitable evidence of its reputation, adding that it is inconceivable that the Respondent would not have been aware of this when registering the disputed domain name.

Finally, the nature of the disputed domain name, comprising the Complainant's mark almost in its entirety together with a well-known abbreviation as prefix and an obvious misspelling at the end, indicates an awareness of the Complainant and its mark and there is a risk that Internet users will not notice the subtle misspelling. Therefore, the Panel finds that the nature of the disputed domain name carries a risk of implied affiliation with the Complainant as it may mistakenly be seen as effectively impersonating or suggesting some connection to the Complainant that does not exist. The Panel takes note of the disclaimer on the website.<sup>1</sup> However, such disclaimer does not prominently and accurately disclose the relationship between the parties. Considering the overall impression of the Respondent's website, the Panel considers that it is likely to cause the Internet user's confusion. Furthermore, the use of the disputed domain name in connection with providing the Complainant's content for downloading without authorization does not confer any rights or legitimate interests on the Respondent.

Based on the available record, the Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

As stated in many decisions rendered under the Policy both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has established rights in the registered trademark SCRIBD, long before the registration of the disputed domain name. Further, the trademark SCRIBD is distinctive and has a widespread recognition in the field of online libraries.

It is inconceivable for this Panel that the Respondent has registered and used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive registered trademark almost entirely, together with an obvious and intentional misspelling of the Complainant's SCRIBD mark (omitting the letter "d") and the well-known abbreviation for "download" ("dl") as prefix.

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<sup>1</sup>"DLScrub.one is not affiliated with Scribd.com or any other sites. We don't host files and only download publicly accessible documents. It's advisable to buy a legal Scribd subscription for full access. We don't support unauthorised distribution of copyrighted material. Users must comply with laws when using our tool."

All of these facts indicate that the Respondent must have been aware of the Complainant's business and trademark when registering the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The Complainant put forward evidence that the disputed domain name resolved to a website which contained the Complainant's registered trademark, and where the Respondent provided a download function for electronic documents as well as information about downloading content from the Complainant's website.

In doing so, the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy – this constitutes bad faith registration and use of the disputed domain name.

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <dlscrib.one> be transferred to the Complainant.

*/Peter Burgstaller/*

**Peter Burgstaller**

Sole Panelist

Date: August 30, 2024